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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,287	10/20/2003	James R. McDonald	MCDZ 2 00001	3155
7590	01/19/2005		EXAMINER	
Scott A. McCollister Fay, Sharpe, Fagan, Minnich & McKee, LLP Seventh Floor 1100 Superior Avenue Cleveland, OH 44114-2518			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 01/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/689,287	MCDONALD, JAMES R.	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 19 November 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/19/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites the limitation "the opening" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-9, 11-12, 14-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Spoonster.

Spoonster discloses a golf grip alignment apparatus having a first portion (Fig. 5, Ref. No. 11), a second portion (Fig. 5, Ref. No. 12) having a recessed seat (Fig. 1, Ref. No. 21), a hinge connecting a first portion to a second portion (Fig. 4), a tab (Fig. 5, Ref.

No. 17) extending from a least one of the first portion and the second portion, a second portion defining an opening in the form of the opening for the shaft (Fig. 2), a tab including a concave surface in the form of the inside surface of the tab (Fig. 5, Ref. No. 17), an attachment mechanism (Ref. Nos. 19-20) to selectively attach a first portion to a second portion (Fig. 2), an attachment mechanism including components (Ref. Nos. 19-20) attached to the tab (Figs. 1-2), an indicator in the form of the edges of the first and second portions along the entire length of the apparatus including adjacent the tab (Fig. 1) able to indicate if the apparatus is completely closed over a club, a tab having a surface able to receive a golfer's thumb (Fig. 1) and a seat (21) able to receive at least one of golfer's fingers, a tab being disposed 180 degrees from a seat in the form of the tab being on the upper body (Ref. No. 11) and the seat being on the lower body (Ref. No. 12) (Fig. 1), a protuberance extending from a body in the form of the rise between the seats (Fig. 1, Ref. No. 21), a protuberance between seats adjacent an opening in the form of when the body portions are separated the protuberances will be next to the edge of the opening (Fig. 1), and a protuberance transitioning into a tab (See enclosure (1)).

5. Claims 14-16 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Stafford.

Stafford discloses a grip alignment device having a tab (Fig. 1, Ref. No. 40) in the form of an extension from a body, a recessed seat defining an opening (Fig. 1), a protuberance adjacent a seat (Fig. 1, Ref. No. 46), a body having a substantially

cylindrical configuration (Figs. 1, 1A), and an attachment mechanism attaching a first portion to a second portion in the form of molding (Col. 4, Lns. 25-28).

6. Claims 14,16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tosti.

Tosti discloses a golf grip alignment device able to fit on a golf club (Figs. 2, 6), a tab (42) extending from the body in the form when the grip is in an opened position (Figs. 4-5), a tab having a surface able to receive a golfer's thumb in the form when the grip is in the open position (Fig. 4), a recessed seat in the form of the inner cylindrical surface where a shaft is seated (Ref. Nos. 43,45, Fig. 4) able to receive at least one of the golfer's fingers in the form when the grip is in the open position (Fig. 4), a seat defining an opening in a body in the form of inner cylindrical surface at the bottom of the grip where there is an opening where the shaft enters (Figs. 1 and 4), and an hinge (Fig. 5).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spoonster in view of Bamber.

Spoonster lacks an opening being substantially elliptical. Bamber discloses a club having an elliptical shape (Figs. 2-3). In view of the patent of Bamber it would have been obvious to modify the apparatus of Spoonster to have an opening in a second portion being substantially elliptical in order to place the apparatus over a club having a shaft and grip being elliptical.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spoonster in view of Cummings.

Spoonster lacks an indicator being an arrow. Cummings discloses a grip having an arrow in order to show a golfer the position of his club, grip and ball with regard to his hands (Fig. 3, Col. 5, Lns. 39-43). In view of the patent of Cummings it would have been obvious to modify the apparatus of Spoonster to have an indicator being an arrow in order to show a golfer the position of his club, grip and ball with regard to his hands.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spoonster in view of Robinson.

Spoonster lacks an apparatus having slip resisting members extending from an inner surface of a first portion. Robinson discloses a grip training apparatus having an slip resisting members extending from an inner surface of a first portion (Fig. 2) in order to prevent the device from slipping vertically or radially about a handle (Col. 4, Lns. 1-8).

In view of the patent of Robinson it would have been obvious to modify the apparatus of Spoonster to have an apparatus having slip resisting members extending from an inner surface of a first portion in order to prevent the device from slipping vertically or radially about a handle.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 16 January 2005



STEPHEN BLAU  
PRIMARY EXAMINER

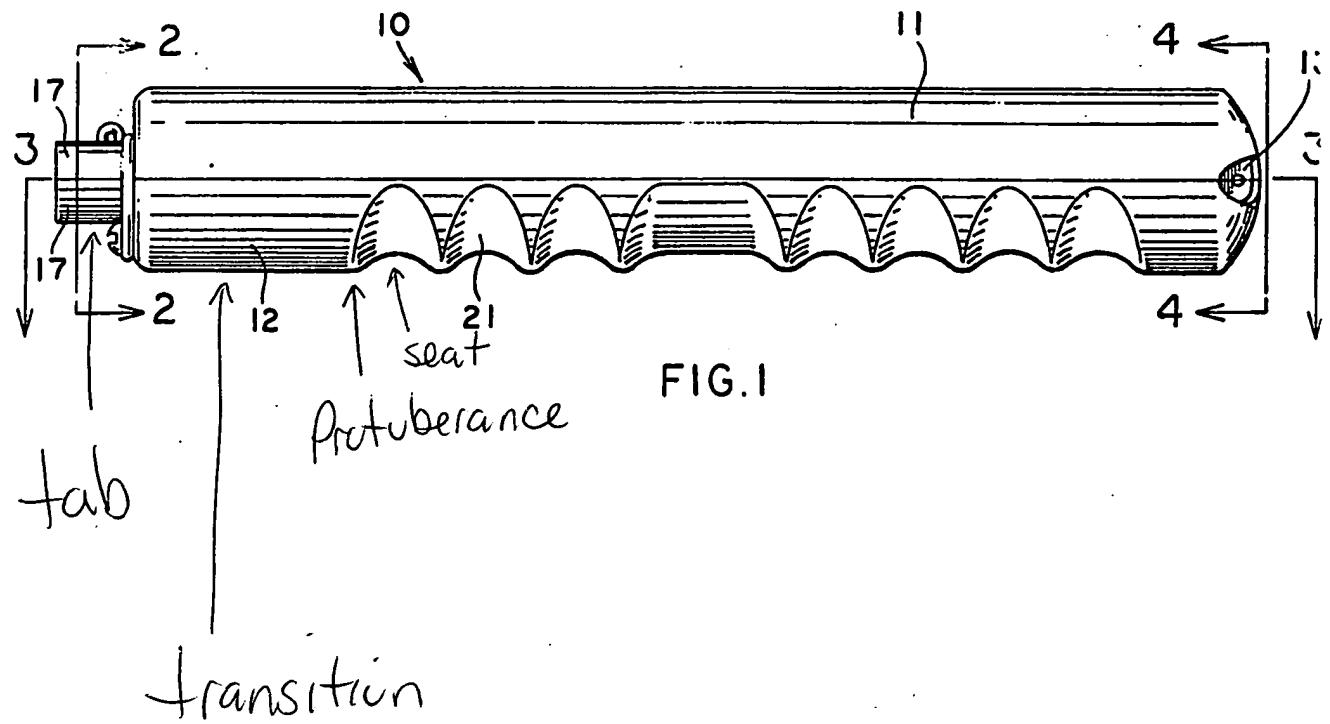


FIG.1

Enclosure (1)